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October 27, 2010

Via ECF

Honorable Judge Joanna Seybert
United States District Court, Eastern District of New York
Alfonse M. D'Amato Federal Building
100 Federal Plaza
Central Islip, NY 11722

Re: *Wayne Lederer v. Newmatic Sound Systems, Inc.*
Case No. 10-cv-0271-JS-AKT

**Defendant's Pending Motion to Stay this Action Pending Reexamination
of the Patent in Suit**

Dear Judge Seybert:

We represent the Defendant in the above-referenced action. The Request for Reexamination referenced in Defendant's fully-briefed and pending Motion to Stay has been granted by the Patent and Trademark Office (PTO). The PTO determined that Defendant's Request, which was based on prior art not previously considered by the PTO, raised "substantial new questions of patentability" as to all of the claims of Plaintiff's patent. A copy of the PTO Order Granting Reexamination is attached for the Court's reference. As detailed in Defendant's moving papers, based on historical results at the PTO, there is a 76% chance that one or more of the claims in Plaintiff's patent will be cancelled or amended as a result of the reexamination.

Accordingly, Defendant respectfully suggests that Defendant's pending motion is ripe for determination and that a Stay of the proceeding in favor of the now granted PTO Reexamination is appropriate.

Very truly yours,

LACKENBACH SIEGEL

A handwritten signature in black ink, appearing to read "Robert B. Golden". The signature is stylized with a large, sweeping "R" and a long horizontal stroke at the end.

Robert B. Golden

RBG/ns

cc: Edmond Bannon, Esq. and Mark L. Manewitz, Esq.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,133	08/03/2010	7609844	01307.L2	8360
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DATE MAILED: 10/25/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,133.

PATENT NO. 7609844.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/011,133	7609844	
	Examiner	Art Unit	
	SCOTT L. WEAVER	3992	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 03 August 2010 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☒ Other: Decision on Request

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester (if third party requester)

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Decision on Request for Ex Parte Reexamination

Reexamination has been requested for Claims 1-8 of the U.S. Pat. No. 7,609,844 (the '844 patent) to Lederer (Exhibit A) which issued on October 27, 2009.

The application on which the '844 patent is based was filed on September 7, 2007, as a divisional application of application No. 10/723,774, which was filed on November 26, 2003.

The parent 10/723,774, application matured into U.S. Pat. No. 7,292,704 and claimed priority to U.S. provisional application No. 60/514,796, filed on October, 27, 2003, provisional application No. 60/514,802, filed October 27, 2003, provisional application No. 60/515,041, filed October 28, 2003, and provisional application no. 60/516,482, filed October 31, 2003.

A substantial new question of patentability affecting claims 1-8 of United States Patent Number 7, 609, 844 to Lederer is raised by the request for reexamination filed on August 3, 2010 for the reasons set forth below.

Right to Waive Patent Owner Statement

Where the patent owner has determined that a statement under 37 CFR 1.530 will not be filed, the patent owner may expedite the reexamination proceeding by filing a paper that indicates that the patent owner waives the filing of a statement under 37 CFR 1.530 and serving the waiver on the requester, if any. This will permit reexamination of the proceeding to proceed pursuant to 37 CFR 1.550(a).

Substantial New Question of Patentability

For "a substantial new question of patentability" (SNQ) to be present, it is only necessary that:

A. The prior art patents and or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the prior art patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; it is not necessary that the prior art establish a prima facie case of unpatentability; and

B. The same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

For any reexamination ordered on or after November 2, 2002, reliance on previously Cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. See MPEP 2642.

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Prior Art Relied on in the Request

The Request identifies the following documents as allegedly raising a substantial new question of patentability (SNQ) for original claims 1-8 of United States Patent 7,609,844.

B. The Newmatic Sound Systems Product Description and Pricing Guide for calendar year 2000 and a page from the Newmatic Sound Systems on-line catalog for 2001 Exhibit B.

C. U.S. Pat. No. 4,864,610, to Stevens, Exhibit C.

D. U.S. Pat. No. 5,613,222, to Guenther, Exhibit D.

E. U.S. Pat. No. 5,277,184, to Messana, Exhibit E.

F. U.S. Pat. No. 4,933,981, to Lederer, Exhibit F.

G. U.S. Pat. No. 4,347,911, to Bertagna et al, as Exhibit G.

H. U.S. Pat. No. 3,667,569, to Mackey et al Exhibit H.

I. U.S. Pat. No. 4,554,993, to Houn, Exhibit I;

J. U.S. Pat. No. 5,577,504, to Salloway et al, Exhibit J.

The Request Identifies 27 Issues as raising a Substantial New Question

Issue 1

A. A substantial new question of patentability as to Claim 1 is raised by the year 2000 Newmatic Sound Systems Product Description (the 2000 NSS Brochure), in view of Stevens (U.S. Pat. No. 4,864,610).

Issue 2

B. A substantial new question of patentability as to Claim 1 is raised by the 2000 NSS Brochure, in view of Guenther (U.S. Pat. No. 5,613,222).

Issue 3

C. A substantial new question of patentability as to Claims 2-3 is raised by the 2000 NSS Brochure, in view of Messana (U.S. Pat. No. 5,277,184), and further in view of Stevens '610

Issue 4

D. A substantial new question of patentability as to Claims 2-3 is raised by the 2000 NSS Brochure, in view of Messana '184, and further in view of Guenther (U.S. Pat. No 5,613,222)

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Issue 5

E. A substantial new question of patentability as to Claims 1-3 is raised by Lederer (U.S. Pat. No. 4,933,981) in view of Bertagna et al (U.S. Pat. No. 4,347,911), and further in view of Stevens '610

Issue 6

F. A substantial new question of patentability as to Claims 1-3 is raised by Lederer '981 in view of Bertagna '911, and further in view of Guenther '222 (U.S. Pat. No 4,864,610)

Issue 7

G. A substantial new question of patentability is raised as to Claims 1-3 by Lederer '981 in view of Houg (U.S. Pat. No. 4,554,993) and further in view of Stevens '610

Issue 8

H. A substantial new question of patentability as to Claims 1-3 is raised by Lederer '981 in view of Houg '993 and further in view of Guenther '222

Issue 9

I. A substantial new question of patentability as to Claims 1-3 is raised by Lederer '981 in view of Mackey et al (U.S. Pat. No. 3,667,569), and further in view of Stevens '610

Issue 10

J. A substantial new question of patentability as to Claims 1-3 is raised by Lederer '981 in view of Mackey '569, and further in view of Guenther '222

Issue 11

K. A substantial new question of patentability as to Claim 4 is raised by the 2000 NSS Brochure, in view of Stevens '610, and further in view of Salloway, et al (U.S. Pat. No. 5,577,504)

Issue 12

L. A substantial new question of patentability as to Claim 4 is raised by the 2000 NSS Brochure, in view of Guenther '222, and further in view of Salloway '504

Issue 13

M. A substantial new question of patentability as to Claim 4 is raised by Lederer '981 in view of Bertagna '911, and further in view of Stevens '610 and Salloway (U.S. Pat. No 5,577,504)

Issue 14

N. A substantial new question of patentability as to Claim 4 is raised by Lederer '981 in view of Bertagna '911, and further in view of Guenther '222 and Salloway '504

Issue 15

O. A substantial new question of patentability as to Claim 4 is raised by Lederer '981 in view of Houg '993, and further in view Stevens '610 and Salloway '504

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Issue 16

P. A substantial new question of patentability as to Claim 4 is raised by Lederer '981 in view of Houg '993, and further in view of Guenther '222 and Salloway '504

Issue 17

Q. A substantial new question of patentability as to Claim 4 is raised by Lederer '981 in view of Mackey '569, and further in view of Stevens '610 and Salloway '504

Issue 18

R. A substantial new question of patentability as to Claim 4 is raised by Lederer '981 in view of Mackey '569, and further in view of Guenther '222 and Salloway '504

Issue 19

S. A substantial new question of patentability as to Claims 5-6 is raised by the 2000 NSS Brochure

Issue 20

T. A substantial new question of patentability as to Claim 7 is raised by the 2000 NSS Brochure, in view of Messana '184

Issue 21

U. A substantial new question of patentability as to Claims 5-7 is raised by Lederer '981 in view of Bertagna '911

Issue 22

V. A substantial new question of patentability as to Claims 5-7 is raised by Lederer '981 in view of Houg '993

Issue 23

W. A substantial new question of patentability as to Claims 5-7 is raised by Lederer '981 in view of Mackey '569

Issue 24

X. A substantial new question of patentability as to Claim 8 is raised by the 2000 NSS Brochure in view of Salloway '504

Issue 25

Y. A substantial new question of patentability as to Claim 8 is raised by Lederer '981 in view of Bertagna '911, and further in view of Salloway '504

Issue 26

Z. A substantial new question of patentability as to Claim 8 is raised by Lederer '981 in view of Houg '993, and further in view of Salloway '504

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Issue 27

AA. A substantial new question of patentability as to Claim 8 is raised by Lederer '981 in view of Mackey '569, and further in view of Salloway '504

Summary of the '844 Patent

The application on which the '844 patent is based was filed on September 7, 2007, as a divisional application of application No. 10/723,774, which was filed on November 26, 2003.

The '844 patent discloses a stethoscope type headset for use in a magnetic environment, for example an MRI, and thus includes a pneumatic tubing coupling a transducer to a pneumatic port which port enables audio to be transmitted to the wearer of such headset when inserted into the ear.

The term "pneumatic port" is recited in the '844 specification and is shown in the drawings as element 106 in the figures, and its structure is textually described as follows:

The pneumatic port 106 may be in the form of a hollow tube and disposed within the ear insert hole 204. The pneumatic port 106 can provide coupling of sound to the ear canal without substantially disturbing the contact between the ear insert and ear canal walls. [Col. 2, lines 60-63.]

The functions of the pneumatic port is set out in the independent claims themselves, which recite that the pneumatic port is disposed in the hole in the ear insert to receive audible sound waves and couple the sound waves to the ear canal. The pneumatic port is a hollow tube disposed in a through hole in an ear insert and mechanically connected to the pneumatic tubes of a headset to acoustically couple sound from a non-magnetic transducer to the wearer's ear.

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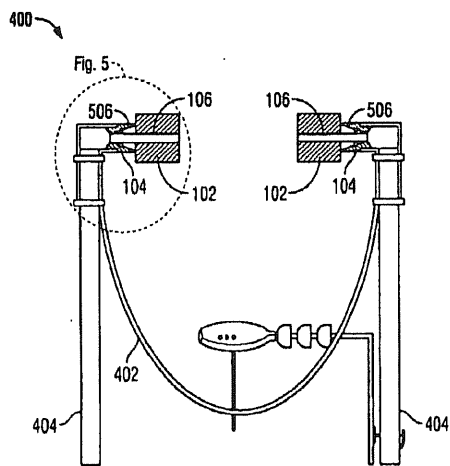


FIG. 4

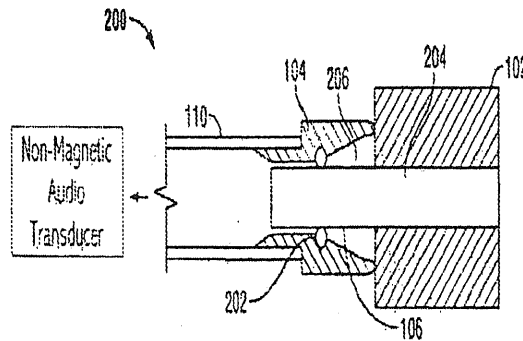


FIG. 2

The '844 specification includes disclosure of structures that may support and connect the pneumatic port to the pneumatic tubes. However, neither the adapter nor any other connection structure or arrangement is set out in the claims. For instance, the specification recites that:

An adapter 104 may be used to support the pneumatic port and can couple the port to pneumatic tubing 110. [Col. 2, lines 47-50]

The adapter 104 may be used to couple the pneumatic port 106 to the pneumatic tube 110. In an implementation, the adapter may have a conical opening 206 to help guide the pneumatic port 106 into the pneumatic tube 110. The adapter may comprise a gasket 202 such as an O-ring disposed in the adapter to support, retain or help seal the pneumatic port 106 in the adapter 104. [Col. 2, line 66 - col. 3, line 5]

The adapter 506 may be used to couple the pneumatic port 106 to the pneumatic tube 404. In an implementation, the adapter may have a conical opening on a first end 508 to help guide and support the pneumatic port 106 into a yoke connector 502. The adapter may comprise a gasket 510 such as an O-ring disposed in the adapter to support, retain or help seal the pneumatic port 106 in the adapter 506. A second end of the adapter 506 is sized to fit snugly into a first end of the yoke connector 502 so as to reduce sound losses in the connection. Other connection arrangements may be used. [Col. 4, lines 1-12.]

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Prosecution History of the '844 Patent

The originally filed application included 34 claims, of which claims 1-20 and 25-34 were canceled and new claims 35-38 were added in a preliminary amendment filed concurrently with the application. Claim 21, as later amended, issued as Claim 1, and Claim 35, as later amended, issued as independent claim 5.

Claims 21-24 and 35-38 were rejected by the examiner based on 35 U.S.C. § 103(a) as being unpatentable over Orten (U.S. Pat. No. 6,741,719) in view of Harley (U.S. Pat. No. 5,539,831). The '719 patent to Orten discloses an electronic stethoscope. The '831 patent to Harley describes an electronic active noise control stethoscope.

In response to the rejections, Patentee amended each of claims 21 and 35 to recite that the stethoscope yoke of the claimed magnetically inert headset included "pneumatic tubing acoustically coupled to both the pneumatic port and a non-magnetic transducer" to couple the audible sound waves from the non-magnetic transducer [emphasis added]. The Patentee argued that claims 21 and 35 distinguished over the cited art because it would not have been obvious to include pneumatic tubing in either of the electronic devices described in the references.

A second office action on May 15, 2009 included a rejection of the claims on basis of U.S. Pat. No. 3,790,712 to Andries, U.S. Pat. No. 3,730,290 to Scanlon, U.S. Pat. No. 5,539,831 to Harley, and U.S. Pat. No. 6,741,719 to Orten.

In response to the rejection the Patentee argued the independent claims as then presented distinguished over the art by reciting a "'magnetically inert headset' that includes a 'stethoscope-type yoke,' an 'ear insert having a through-hole,' a 'pneumatic port disposed in the ear insert to receive audible sound waves,' and 'pneumatic tubing acoustically coupled to both the pneumatic port and a non-magnetic transducer.'" [Patentee's, "Amendment in Reply to Action of May 15, 2009," p. 3, line 27 to p. 4, line 2; emphasis in the original.]

The Patentee further argued that none of the references teach or render obvious "a 'pneumatic port' disposed in a through-hole of an ear insert to receive audible sound waves from 'pneumatic tubing acoustically coupled to the pneumatic port.'" [Id. at p. 4, line 25, through p. 5, line 2; emphasis in original.]

An interview followed and a Notice of Allowance was mailed on August 24, 2009. The reasons for allowance with respect to the art relied on were indicated as:

"A magnetically inert headset comprising: *an ear insert having a through-hole and adapted to fit into an ear canal; a pneumatic port disposed in the hole in the ear insert to receive audible sound waves and couple the sound waves to the ear canal; a non-magnetic microphone coupled to the headset; and a stethoscope-type yoke, wherein the yoke includes pneumatic tubing acoustically coupled to both the pneumatic port and a non-*

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magnetic transducer to couple the audible sound waves from the non-magnetic transducer.

As per our interview, in this way, the through-hole in the ear insert is not directly coupled to the pneumatic tubing. Instead, there is a port disposed between the hole and the tubing.

The Patentee further commented in a post allowance communication on 9/14/2009 in response to the reasons for allowance :

The Examiner's allowance of the claims is appreciated. The Applicant submits the following comments concerning the Examiner's Reasons for Allowance cited in the Notice of Allowability. It is the subject matter of each claim as a whole that is patentable, not any particular feature recited in the claim(s). The Applicant does not concede that the reasons for allowance given by the Examiner are the only reasons that make the claims allowable and does not make any admission or concession concerning the Examiner's statement.

Claim 1 reads as follows:

1. A magnetically inert headset comprising: an ear insert having a **through-hole** and adapted to fit into an ear canal; a **pneumatic port disposed in the hole in the ear insert** to receive audible sound waves and couple the sound waves to the ear canal; a **non-magnetic microphone** coupled to the headset; and a **stethoscope-type yoke**, wherein the yoke includes **pneumatic tubing acoustically coupled to both the pneumatic port and a non-magnetic transducer** to couple the audible sound waves from the non-magnetic transducer.

Independent Claim 5 lacks recitation of the microphone of independent claim 1.

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Discussion of Issues Raised in the Request

The substantial new Questions of patentability are grouped based on two primary references.

Issues 1-4, 11-12, 19-20, and 24 identified in the request as (A, B, C, D, K, L, S, T, and X) rely on Newmatic (NSS) as the Primary reference.

B. The Newmatic Sound Systems Product Description and Pricing Guide for calendar year 2000 and a page from the Newmatic Sound Systems on-line catalog for 2001 Exhibit B (NSS).

Issue 19

The request alleges that NSS raises an SNQ with respect to claims 5-6 of the '844 Patent.

It is agreed that NSS raises an SNQ with respect to claims 5-6 of the '844 Patent (Issue 19).

NSS was not present or considered by the Examiner during the original examination of the '844 patent and a reasonable Examiner would consider that the teachings in the NSS reference are important in determining whether or not claims 5-6 were patentable.

An Examiner would consider NSS new, important, and non-cumulative prior art because NSS describes a "completely pneumatic" stethoscope type head set (FEHPS).

The Foam Ear Piece Head Set (FEPHS), shown on page 12 and is described on page 13 as follows: "Stethoscope style headset with disposable foam ear tips. Lightweight and flexible, fits easily into any head coil. Fits adults and children alike. Completely pneumatic."

The FEPHS includes a pneumatic port (an acoustic horn) including a tube which has a tube disposed at its upper end in the hole in the ear insert to receive sound waves in order to couple the sound waves to the ear canal.

NSS describes Newmatic Sound Systems products including four sound systems to be used in MRI environments. Each system is described as using a "nonferrous" transducer on pages 8-9 of the brochure.

The photograph at page 12 of the 2000 NSS Brochure shows a magnetically inert headset (the "FEPHS" headset) that includes an ear insert having a through-hole (the foam ear tip inherently has a through-hole in order for the wearer to utilize the sound systems as described);

a pneumatic port (the horn extending from the foam ear tip extends outwardly from the user's ear and curves downwardly) disposed in the hole in the ear insert to receive audible sound waves and couple the sound waves to the ear canal

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a stethoscope-type yoke , wherein the yoke includes pneumatic tubing acoustically coupled to both the pneumatic port (the horn) and a non-magnetic transducer (the sound system) to couple the audible sound waves from the non-magnetic transducer

Given the above teachings, there is a substantial likelihood that a reasonable examiner would consider the teachings important in deciding the patentability of claims 5-6 during prosecution of the application which became the '844 patent.

NSS has not been previously considered. The features of NSS discussed herein are not cumulative to any written discussion on the record of the features of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts. The NSS Reference was not before the examiner during prosecution of the application which became the '844 patent. Accordingly, NSS raises a substantial new question of patentability as to claims 5-6 of the '844 patent to Lederer.

Issue 1

The request alleges that the combination of NSS and the '610 patent raise an SNQ with respect to claim 1 of the '844 Patent.

It is agreed that the combination of NSS and the '610 patent raises an SNQ with respect to claim 1 of the '844 Patent.

The combination of NSS and the '610 patent was not present or considered by the Examiner during the original examination of the '844 patent and a reasonable Examiner would consider that the combination of NSS and the '610 patent teachings are important in determining whether or not claim 1 is patentable.

An Examiner would consider the combination of NSS and the '610 patent new, important, and non-cumulative prior art because NSS discloses a "completely pneumatic" stethoscope type head set (FEHPS) as described above with respect to issue 19 but does not disclose a non-magnetic microphone.

The Stevens '610 patent describes an earpiece for a pneumatic headset, and also teaches acoustically connecting a pneumatic microphone to the headset. [See Stevens, FIGS. 1-2, col. 3, lines 1-2.]

The combination as such raises an SNQ for the same reasons as noted above with respect to Issue 19.

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Thus combination teaches especially relevant limitations recited by the claims of the patent, limitations that apparently secured allowance of the claim and which were indicated not to be taught by the applied prior art of record considered by the examiner in the original prosecution. Given the above teachings, there is a substantial likelihood that a reasonable examiner would consider the teachings important in deciding the patentability of claim 1 during prosecution of the application which became the '844 patent.

The combination has not been previously considered. The features discussed herein are not cumulative to any written discussion on the record of the features of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts. The combination was not before the examiner during prosecution of the application which became the '844 patent.

Accordingly, the combination raises a substantial new question of patentability as to claim 1 of the '844 patent.

Issue 2

The request alleges that NSS and the '222 patent raise an SNQ with respect to claim 1 of the '844 Patent.

It is agreed that the combination of NSS and the '222 patent raises an SNQ with respect to claim 1 of the '844 Patent.

The combination of NSS and the '222 patent was not present or considered by the Examiner during the original examination of the '844 patent and a reasonable Examiner would consider that the combination of NSS and the '222 patent teachings are important in determining whether or not claim 1 is patentable.

An Examiner would consider the combination of NSS and the '222 patent new, important, and non-cumulative prior art because NSS discloses a "completely pneumatic" stethoscope type head set (FEHPS) as described above with respect to issue 19 but does not disclose a non-magnetic microphone.

The '222 patent to Guenther describes an earpiece for a pneumatic headset, and also teaches acoustically connecting a pneumatic microphone to the headset. [See Guenther '222, FIGS. 13-14, col. 6, lines 28-46.]

The combination as such raises an SNQ for the same reasons as noted above with respect to Issue 19.

Thus combination teaches especially relevant limitations recited by the claims of the patent, limitations that apparently secured allowance of the claim and which were indicated not to be taught by the applied prior art of record considered by the examiner in the original prosecution.

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Given the above teachings, there is a substantial likelihood that a reasonable examiner would consider the teachings important in deciding the patentability of claim 1 during prosecution of the application which became the '844 patent.

The combination has not been previously considered. The features discussed herein are not cumulative to any written discussion on the record of the features of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts. The combination was not before the examiner during prosecution of the application which became the '844 patent.

Accordingly, the combination raises a substantial new question of patentability as to claim 1 of the '844 patent.

Issues 3-4, 11-12, 20 and 24

Other issues alleged by the Requestor relating to NSS in combination with other cited references, specifically Issues 3-4, 11-12, 20 and 24 raise an SNQ for claims 2-3 and 7-8 for the same reasoning set forth above with respect to Issue 19.

Issue 21

The request alleges that the combination of Lederer '981 and the '911 patent raise an SNQ with respect to claims 5-7 of the '844 Patent.

It is agreed that the combination of Lederer '981 and the '911 patent raises an SNQ with respect to claims 5-7 of the '844 Patent.

Lederer '981 expressly provides that the sound "is transferred pneumatically from the vibrating transducers to the appropriate headset, e.g., based on the bernoulli principle. Any conventional headset may be coupled to the acoustic system in the present invention, e.g., a headset disclosed in U.S. Pat. No. 4,347,911. In this regard, another feature of the present invention is a particular earpiece which can be utilized in the headset incorporated to the acoustic system herein, e.g. the headset disclosed in U.S. Pat. No. 4,347,911." [Col. 5, lines 20-30.]

Bertagna '911 discloses an acoustic plastic headset having a yoke supporting sound-transmitting horns which terminate in soft tips for insertion in a user's ears [FIGS. 1, 6; col. 1, lines 55-66; col. 2, lines 44-49]. At their upper ends, the horns 22 taper in a portion (sleeve 27) that is disposed in a through-hole in an ear insert 33 [FIGS. 1, 6; col. 3, lines 10-63], precisely as the pneumatic port 106 of the '844 patent. The other ends of the horns include shoulders 23, 24, which provide a bracket for coupling a stethoscope-type connector 13, and pneumatic tubes 40, 41 are acoustically coupled to the pneumatic ports. [Id.] FIG. 6

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The combination of Lederer '981 and the '911 patent was not present or considered by the Examiner during the original examination of the '844 patent and a reasonable Examiner would consider that the combination of Lederer '981 and the '911 patent teachings are important in determining whether or not claims 5-7 are patentable.

An Examiner would consider the combination of Lederer '981 and the '911 patent new, important, and non-cumulative prior art.

Thus the combination teaches especially relevant limitations recited by the claims of the patent, limitations that apparently secured allowance of the claim and which were indicated not to be taught by the applied prior art of record considered by the examiner in the original prosecution. Given the above teachings, there is a substantial likelihood that a reasonable examiner would consider the teachings important in deciding the patentability of claim 5-7 during prosecution of the application which became the '844 patent.

The combination has not been previously considered. The features discussed herein are not cumulative to any written discussion on the record of the features of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts. The combination was not before the examiner during prosecution of the application which became the '844 patent.

Accordingly, the combination raises a substantial new question of patentability as to claims 5-7 of the '844 patent.

Issues 5-6, 13-14, and 25

Other issues alleged by the Requestor relating to Lederer '981 in combination with other cited references, specifically Issues 5-6, 13-14, and 25 raise an SNQ for claims 1-3 and 7-8 for the same reasoning set forth above with respect to Issue 21.

Issue 22

The request alleges that the combination of Lederer '981 and the '993 patent raise an SNQ with respect to claims 5-7 of the '844 Patent.

Lederer '981 is discussed above with respect to issue 21.

Houng '993 teaches a headset that includes an ear insert 9 having a through-hole [FIG. 5] adapted to fit into an ear canal [col. 1, lines 21-24]; a pneumatic port 1 is disposed in the hole in the ear insert to receive audible sound waves and couple the sound waves to the ear canal [FIGS. 1a, 2, 5, and 6]; and a stethoscope-type yoke [FIGS. 1 a, 2], wherein the yoke includes pneumatic tubing 7 acoustically coupled to both the pneumatic port and a transducer to couple the audible sound waves from the non-magnetic transducer [FIGS. 1 a, 2, 6].

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The combination of Lederer '981 and the '993 patent was not present or considered by the Examiner during the original examination of the '844 patent and a reasonable Examiner would consider that the combination of Lederer '981 and the '993 patent teachings are important in determining whether or not claims 5-7 are patentable.

An Examiner would consider the combination of Lederer '981 and the '993 patent new, important, and non-cumulative prior art.

Thus the combination teaches especially relevant limitations recited by the claims of the patent, limitations that apparently secured allowance of the claim and which were indicated not to be taught by the applied prior art of record considered by the examiner in the original prosecution. Given the above teachings, there is a substantial likelihood that a reasonable examiner would consider the teachings important in deciding the patentability of claim 5-7 during prosecution of the application which became the '844 patent.

The combination has not been previously considered. The features discussed herein are not cumulative to any written discussion on the record of the features of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts. The combination was not before the examiner during prosecution of the application which became the '844 patent.

Accordingly, the combination raises a substantial new question of patentability as to claims 5-7 of the '844 patent.

Issues 7-8, 15-16, and 26

Other issues alleged by the Requestor relating to Lederer '981 in combination with other cited references, specifically Issues 7-8, 15-16, and 26 raise an SNQ for claims 1-3 and 7-8 for the same reasoning set forth above with respect to Issue 22.

Issue 23

The request alleges that the combination of Lederer '981 and the '569 patent raise an SNQ with respect to claims 5-7 of the '844 Patent.

Lederer '981 is discussed above with respect to issue 21.

Mackey '569 describes a yoke that includes pneumatic tubing 12, 14 acoustically coupled to both the pneumatic port (L-shaped members 42, 44) to couple the audible sound waves from a transducer [FIGS. 1, 2, 4; col. 3, lines 8-30]. Figs. 2 and 4 are shown below.

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The combination of Lederer '981 and the '569 patent was not present or considered by the Examiner during the original examination of the '844 patent and a reasonable Examiner would consider that the combination of Lederer '981 and the '569 patent teachings are important in determining whether or not claims 5-7 are patentable.

An Examiner would consider the combination of Lederer '981 and the '569 patent new, important, and non-cumulative prior art.

Thus the combination teaches especially relevant limitations recited by the claims of the patent, limitations that apparently secured allowance of the claim and which were indicated not to be taught by the applied prior art of record considered by the examiner in the original prosecution. Given the above teachings, there is a substantial likelihood that a reasonable examiner would consider the teachings important in deciding the patentability of claim 5-7 during prosecution of the application which became the '844 patent.

The combination has not been previously considered. The features discussed herein are not cumulative to any written discussion on the record of the features of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts. The combination was not before the examiner during prosecution of the application which became the '844 patent.

Accordingly, the combination raises a substantial new question of patentability as to claims 5-7 of the '844 patent.

Issues 9-10, 17-18, and 27

Other issues alleged by the Requestor relating to Lederer '981 in combination with other cited references, specifically Issues 9-10, 17-18, and 27 raise an SNQ for claims 1-3 and 7-8 for the same reasoning set forth above with respect to Issue 23.

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Conclusion

Claims 1-8 of the '844 patent will be reexamined.

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the instant patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

This *ex parte* reexamination proceeding has been filed by a third party requester, or has been merged with another proceeding filed by a third party requester. Accordingly, the parties to this reexamination proceeding are reminded that, in accordance with 37 CFR 1.550(f), any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding (or parties, where two or more third party requester proceedings are merged), **in the manner provided by 37 CFR 1.248**. If the document filed with the Office does not include a proper certificate of service, the document may be refused consideration by the Office. See MPEP 2220 and 2266.03.

37 CFR 1.550(f) provides:

"The reexamination requester will be sent copies of Office actions issued during the ex parte reexamination proceeding. After filing of a request for ex parte reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office."

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

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Central Reexamination Unit
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United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

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Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/SCOTT L WEAVER/
Primary Examiner, Art Unit 3992

Conferees:

R.C.F.

ESK

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		11851860
	Filing Date		2007-09-07
	First Named Inventor	Lederer, Wayne	
	Art Unit		
	Examiner Name	Curtis Kuntz	
	Attorney Docket Number	01307.L2	

U.S.PATENTS						
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
SW	1	4864610		1989-09-05	Stevens	all
SW	2	5613222		1997-03-18	Guenther	all
SW	3	5277184		1994-01-11	Messana	all
SW	4	4933981		1990-06-12	Lederer	all
SW	5	4347911		1982-09-07	Bertagna et al.	all
SW	6	3667569		1972-06-06	Mackey et al.	all
SW	7	4554993		1985-11-26	Houng	all
SW	8	5577504		1996-11-26	Salloway et al	all
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		11851860
	Filing Date		2007-09-07
	First Named Inventor	Lederer, Wayne	
	Art Unit		
	Examiner Name	Curtis Kuntz	
	Attorney Docket Number	01307.L2	

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Reexamination 	Application/Control No.	Applicant(s)/Patent Under Reexamination
	90/011,133	7609844
	Certificate Date	Certificate Number

Requester	Correspondence Address:	<input type="checkbox"/> Patent Owner	<input checked="" type="checkbox"/> Third Party
<p>STAINBROOK & STAINBROOK, LLP 412 AVIATION BOULEVARD SUITE H SANTA ROSA, CA 95403</p>			

LITIGATION REVIEW <input checked="" type="checkbox"/>	(examiner initials) SLW	9/10/2010 (date)
Case Name		Director Initials
2:10cv271 Lederer v. Newmatic Sound Systems, Inc		<i>Lee Head for</i> <i>HY</i>
3:10cv129 Newmatic Sound Systems, Inc v. Magnacoustics, Inc		↓
5:10cv129 Newmatic Sound Systems, Inc v. Magnacoustics, Inc		

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Search Notes

Application/Control No.

90/011,133

Examiner

SCOTT L. WEAVER

Applicant(s)/Patent under
Reexamination

7609844

Art Unit

3992

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Class	Subclass	Date	Examiner

INTERFERENCE SEARCHED

Class	Subclass	Date	Examiner

**SEARCH NOTES
(INCLUDING SEARCH STRATEGY)**

	DATE	EXMR
Reviewed Prosecution File History	10/15/2010	SLW